> of material fact that any of the Defendants knew or had reason to know of Lockpur's infringement.

Pet. App. 4a-5a (footnotes omitted).

With regard to Contessa's trademark infringement claim, the Ninth Circuit assumed *arguendo* that the Boiling Shrimp image was a protectable trademark. *See id.* at 6a. The court held, however, that Contessa had "not introduced any evidence supporting a reasonable inference that five of the eight Defendants ever used the Image in commerce," *id.* at 6a, and therefore those parties could not be held liable for trademark infringement as a matter of law, *id.* at 7a. As to the other three defendants,

> [a]lthough Contessa has introduced evidence supporting a reasonable inference that defendants Fishery Products, Berdex and Coast to Coast did distribute product in packaging containing the Image, we deny Contessa's request for disgorgement of profits because of an absence of any evidence supporting a reasonable inference that any of the Defendants willfully infringed its alleged trademark.

Id. at 7a (citing *Lindy*, 982 F.2d at 1406).

The court of appeals denied Contessa's petition for rehearing. Contessa then petitioned this Court for a writ of certiorari.

SUMMARY OF ARGUMENT

This Court should deny Contessa's petition on the trademark infringement issue for any of several reasons.

First, Contessa raises the issue far too late. This Court does not ordinarily allow a petitioner to assert new

issues not raised in the lower courts. In neither the district court nor the court of appeals did Contessa argue, as it now does, that willfulness is not a prerequisite for an award of profits for violation of section 43(a) of the Lanham Act. On the contrary, in both courts, Contessa assumed willfulness was a prerequisite and attempted to show that the evidence created a triable issue of fact whether defendants' infringement was willful. Consequently, the court of appeals' Memorandum decision did not address or discuss the issue Contessa now raises, and neither should this Court.

Second, Contessa relies on the August 1999 amendments to section 35(a) of the Lanham Act, 15 U.S.C.A. § 1117(a), and cases construing the statute as amended, to support its position that the courts are in conflict on the question whether willfulness is a prerequisite for an award of profits for violation of section 43(a) of the Act, 15 U.S.C.A. § 1125(a). But the 1999 amendments, which changed the statutory requirement of willfulness, do not apply here. The conduct of which Contessa complained occurred in 1997 and 1998; it was governed by the pre-1999 version of section 35(a). Most courts construed the pre-1999 version of section 35(a) to require proof of willfulness as a prerequisite for an order requiring defendant to disgorge profits. The court of appeals here correctly decided the case under the pre-1999 version of section 35(a). Any perceived conflict in the decisions construing the pre- and post-1999 versions of the statute is a false conflict, explainable by the 1999 change in the statutory language.

Third, the cases that have construed the current version of section 35(a) are not in conflict. Two circuits have considered whether willfulness is a prerequisite for an award of profits under the current version of section 35(a), and they reached consistent results. So this Court

has no reason to construe the current version of the statute.

Fourth, with respect to decisions construing the pre-1999 version of section 35(a), which applies here, Contessa overstates the supposed circuit conflict. Most of the circuits interpreted the pre-1999 version of the statute to require willfulness as a prerequisite for disgorgement; *none* held that a defendant who was ignorant of the infringement (which is the case here) could be ordered to disgorge profits. In any event, this Court has little reason to settle a perceived conflict in the interpretation of a statute that was amended in material respects six years ago and that consequently has little or no current legal significance for the issue presented. The Court's interpretation of the now-superseded version of the statute would be of mere historical interest.

Finally, regardless of whether willfulness is a prerequisite for an award of profits, the court of appeals correctly affirmed the judgment because the district court did not abuse its discretion in denying Contessa an award of profits under the facts of this case.

Tacked on to the end of Contessa's petition is a suggestion that remand and reconsideration of Contessa's copyright infringement claim might be appropriate in light of this Court's decision in *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 125 S. Ct. 2764 (2005), which had yet to be filed by the time Contessa filed its petition. Contessa promised to "supplement its petition as appropriate when the opinion in *Grokster* is handed down." Pet. Writ Cert. 24. The opinion in *Grokster* was handed down on June 27, 2005, but Contessa never supplemented its petition. It has apparently abandoned any contention that *Grokster*

justifies remand and has offered no explanation why *Grokster* affects this case. Accordingly, the petition on this issue should be denied as well.

REASONS FOR DENYING THE PETITION

I. CERTIORARI IS UNWARRANTED ON THE TRADEMARK INFRINGEMENT ISSUE FOR NUMEROUS REASONS.

A. The issue Contessa now raises was not raised in the district court or the court of appeals.

This Court does not ordinarily allow a petitioner to present a new issue it never raised in the lower courts. *United States v. United Foods, Inc.*, 533 U.S. 405, 417 (2001) ("Although in some instances we have allowed a respondent to defend a judgment on grounds other than those pressed or passed upon below, *see, e.g., United States v. Estate of Romani*, 523 U.S. 517, 526, n.11, 118 S.Ct. 1478, 140 L.Ed.2d 710 (1998), it is quite a different matter to allow a petitioner to assert new substantive arguments attacking, rather than defending, the judgment when those arguments were not pressed in the court whose opinion we are reviewing, or at least passed upon by it.").

The trademark infringement issue Contessa frames in its petition was not raised in either the district court or the court of appeals.

In the district court, Berdex and Coast moved for summary adjudication of Contessa's claim for an accounting of profits and attorneys' fees for trademark infringement, on the ground Contessa could not establish the

infringement was willful. Pet. App. 32a, n.10. In opposition, Contessa did not dispute that willfulness was a prerequisite to an award of profits. Instead, Contessa argued that "'the requisite intent is found in [Defendants'] willful blindness.'" *Id.* at 33a.

Likewise on appeal, Contessa did not dispute that willfulness was a prerequisite to an award of profits for violation of section 43(a) of the Lanham Act. Rather, Contessa framed the question as whether the evidence was "sufficient to create an issue of fact regarding Appellees' willfulness in infringing Contessa's trademark infringement [*sic*] that defeated summary judgment." CA AOB 2; *see id.* at 39 ("[T]he only remaining issue is whether Contessa's evidence supporting an inference of willfulness in Appellees' infringement is sufficient to reach a jury."). Contessa itself relied on the Ninth Circuit's decision in *Lindy*, which held willfulness was a prerequisite to an award of profits for violation of section 43(a) of the Lanham Act. Contessa asserted it would be entitled to profits if, in fact, defendants' conduct was willful:

> Although profits disgorgement for willful trademark infringement is subject to principles of equity, it is a per se abuse of discretion to fail to order disgorgement adequate to make willful trademark infringement unprofitable. "Where trademark infringement is deliberate and willful, [the Ninth Circuit] has found that a remedy no greater than an injunction 'slights' the public."

CA AOB 39-40 (citations omitted) (quoting *Lindy*, 982 F.2d at 1405).

Again in its petition for rehearing of the court of appeals' decision affirming the judgment, Contessa accepted the proposition that willfulness is a prerequisite for

an award of profits. Contessa simply argued it had satisfied that prerequisite: "The Opinion's asserted absence of evidence supporting a reasonable inference that any Defendant willfully infringed Contessa's trademark is demonstrably false .... All these items [of evidence] combine to support inference [*sic*] of willfulness through affirmative acts or willful blindness." Pet. Reh'g. 6.

Because Contessa consistently framed the issue as whether it had established willfulness, the parties never briefed the issue Contessa now raises – whether willfulness is required at all. For the same reason, neither the district court nor the Ninth Circuit had occasion to consider whether the Ninth Circuit's *Lindy* decision survived the 1999 amendments to section 35(a) of the Lanham Act, an inquiry Contessa now asks this Court to undertake for the first time.

Had Contessa raised this issue in the lower courts, not only would they have considered the issue, but Berdex and Coast would have pressed an alternative argument to support the judgment in their favor – even if willfulness is not a prerequisite, the facts did not support an award of profits. Instead, ever since Berdex and Coast moved for summary adjudication in 2001, the parties have been briefing and arguing the issue whether Berdex and Coast willfully infringed Contessa's claimed trademark. If that is not the issue, then Contessa has wasted four years, consumed scarce judicial resources, and caused Berdex and Coast to incur fees for thousands of hours of attorney time on the wrong issue.

Consistent with its usual practice, this Court should decline to consider Contessa's newly minted trademark infringement issue, which the lower courts had no opportunity to consider because Contessa never raised it.

B. The current version of section 35(a) of the Lanham Act, on which Contessa relies in its petition, does not apply to this case. The alleged infringement occurred before the current version was enacted.

Before August 1999, the first sentence of section 35(a) of the Lanham Act, 15 U.S.C.A. § 1117(a), provided:

> When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, or a violation under section 1125(a) of this title, shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action.

15 U.S.C.A. § 1117(a) (West 1998). Section 1125(a) (section 43(a) of the Lanham Act) prohibits trademark infringement by "any false designation of origin, false or misleading description of fact, or false or misleading representation of fact."

In August 1999, Congress amended the first sentence of section 35(a) to read as follows (new language in italics):

> When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) *or (d)* of this title, *or a willful violation under section 1125(c) of this title,* shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1)

> defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action.

15 U.S.C.A. § 1117(a) (West Supp. 2005) (emphasis added).

Congress's addition of the term "willful violation" changed the meaning of the statute. Before the 1999 amendments, most courts had construed the statute to require proof of willfulness as a prerequisite for an award of defendant's profits for violation of 15 U.S.C.A. § 1125(a). *See, e.g., SecuraComm Consulting Inc. v. Securacom Inc.*, 166 F.3d 182, 190 (3d Cir. 1999); *Bishop v. Equinox Int'l Corp.*, 154 F.3d 1220, 1223 (10th Cir. 1998); *Lindy*, 982 F.2d at 1405; *George Basch Co., Inc. v. Blue Coral, Inc.*, 968 F.2d 1532, 1534 (2d Cir. 1992); *ALPO Petfoods, Inc. v. Ralston Purina Co.*, 913 F.2d 958, 968 (D.C. Cir. 1990); *Burger King Corp. v. Mason*, 855 F.2d 779, 781 (11th Cir. 1988).

As amended, the statute requires proof of willfulness as a prerequisite for an award of defendant's profits for violation of 15 U.S.C.A. § 1125(c) but not 15 U.S.C.A. § 1125(a). *See Banjo Buddies, Inc. v. Renosky*, 399 F.3d 168, 175 (3d Cir. 2005) (holding that 1999 amendments to section 35(a) of Lanham Act superseded Third Circuit's earlier decision in *SecuraComm*, 166 F.3d 182, which required willfulness as prerequisite for profits award for violation of 15 U.S.C.A. § 1125(a)).

In making its case for certiorari, Contessa relies on the current version of section 35(a) of the Lanham Act, claiming the circuits disagree whether the current version requires proof of willfulness before a defendant may be ordered to disgorge profits for violating 15 U.S.C.A. § 1125(a). Pet. Writ Cert. 8-13. But the current version does not apply to this case.

Legislation is considered retroactive if it changes the legal consequences of acts that were completed before the law's effective date. *Miller v. Florida*, 482 U.S. 423, 430 (1987). Courts always presume that legislation is *not* retroactive:

> [T]he presumption against retroactive legislation is deeply rooted in our jurisprudence, and embodies a legal doctrine centuries older than our Republic. Elementary considerations of fairness dictate that individuals should have an opportunity to know what the law is and to conform their conduct accordingly; settled expectations should not be lightly disrupted. For that reason, the "principle that the legal effect of conduct should ordinarily be assessed under the law that existed when the conduct took place has timeless and universal appeal."

Landgraf v. USI Film Prods., 511 U.S. 244, 265 (1994) (footnotes omitted) (quoting *Kaiser Aluminum & Chem. Corp. v. Bonjorno*, 494 U.S. 827, 855 (1990)).

Nothing in the legislation enacting the 1999 amendments to section 35(a) of the Lanham Act suggests they were intended to apply retroactively. Nor does Contessa argue the amendments should apply retroactively.

At issue in this case is conduct by Berdex and Coast that occurred in 1997 and 1998. That conduct was governed by the version of section 35(a) in effect in 1997 and 1998. Contessa's reliance on the post-1999 version of the statute is misplaced.

Any perceived conflict in the decisions construing the pre- and post-1999 versions of the statute is a false conflict, explainable by the 1999 change in the statutory language.

C. There is no conflict in the cases that have construed the current version of section 35(a) of the Lanham Act.

Two circuit courts of appeals have decided the issue whether willfulness is a prerequisite for an award of profits under the current version of section 35(a) of the Lanham Act – and their decisions are consistent.

In *Quick Technologies, Inc. v. Sage Group PLC*, 313 F.3d 338, 349 (5th Cir. 2002), the Fifth Circuit "decline[d] to adopt a bright-line rule in which a showing of willful infringement is a prerequisite to an accounting of profits." The court relied on the 1999 amendments to section 35(a), noting that "the decisions of our sister circuits are of limited utility to the decision we are faced with today" because before the 1999 amendments the statute contained no references to "willful." *Id.* at 348.

More recently, in *Banjo Buddies*, 399 F.3d at 175, the Third Circuit followed *Quick Technologies* and held that, in light of the 1999 amendments to the statute, proof of willfulness was no longer a prerequisite to an accounting of the infringer's profits. The court noted that its earlier decision to the contrary in *SecuraComm*, 166 F.3d 182, had been superseded by the 1999 amendments. 399 F.3d at 175; *see also Gucci America, Inc. v. Daffy's, Inc.*, 354 F.3d 228, 239-43 (3d Cir. 2003) (noting *Quick Technologies*' holding that 1999 amendment supersedes *SecuraComm*'s requirement of willfulness but not reaching issue).

Contessa cites *Tamko Roofing Prods., Inc. v. Ideal Roofing Co., Ltd.*, 282 F.3d 23 (1st Cir. 2002), another case postdating the 1999 amendments. But *Tamko* does not conflict with *Quick Technologies* or *Banjo Buddies*. In *Tamko*, the district court ordered an accounting of profits.

On appeal, the defendant argued an award of profits was not warranted. The appellate court rejected the defendant's argument because the jury found willful infringement and the infringing product directly competed with the trademarked product. *Id.* at 36-37. The court specifically stated it was *not reaching* the issue whether willfulness is a prerequisite for an award of profits. *Id.* at 36. In dictum, it cited *SecuraComm*, 166 F.3d at 190, for the proposition that "when the rationale for an award of defendant's profits is to deter some egregious conduct, willfulness is required." *Tamko*, 282 F.2d at 36 n.11. But, as noted, the *Banjo Buddies* court later determined *SecuraComm* has been superseded by the 1999 Lanham Act amendments. *Banjo Buddies*, 399 F.3d at 175. The *Tamko* court did not discuss the 1999 amendments.

Nor does the Ninth Circuit's decision in the present case create a conflict among the circuits. First, it is unpublished and therefore cannot be cited or relied on in the Ninth Circuit. 9th Cir. R. 36-3. Second, the decision states and applies the rule articulated in *Lindy*, which applied to events that occurred in 1997 and 1998. The Ninth Circuit did not purport to construe or apply the current version of section 35(a) of the Lanham Act. Under these circumstances, the decision will have no effect on current law pertaining to disgorgement of profits for trademark infringement.

In short, there is no conflict in the decisions interpreting the current version of section 35(a) of the Lanham Act and thus no reason for this Court to consider the statute's meaning.

D. Contessa overstates the supposed conflict in the cases that construed the pre-1999 version of section 35(a) of the Lanham Act. In any event, a decision by this Court construing the pre-1999 version of the statute would be of mere historical interest.

The decisions of the courts of appeals under former section 35(a) of the Lanham Act reflected a range of views on what the "principles of equity" required to justify an award of profits. As noted above, however, most courts held that at least willfulness was required. *SecuraComm*, 166 F.3d at 190 ("a plaintiff must prove that an infringer acted willfully before the infringer's profits are recoverable"); *Bishop*, 154 F.3d at 1223; *George Basch*, 968 F.2d at 1534 ("we hold that in order to justify an award of profits, a plaintiff must establish that the defendant engaged in willful deception"); *ALPO Petfoods*, 913 F.2d at 968 ("an award based on a defendant's profits requires proof that the defendant acted willfully or in bad faith"); *Lindy*, 982 F.2d at 1405 (an accounting of profits is appropriate "where the infringement is 'willfully calculated to exploit the advantage of an established mark.'") (quoting *Playboy Enters., Inc. v. Baccard Clothing Co., Inc.*, 692 F.2d 1272, 1274 (9th Cir. 1982)).

Among the pre-1999 cases Contessa cites that supposedly did not require proof of willfulness are *Roulo v. Russ Berrie & Co., Inc.*, 886 F.2d 931 (7th Cir. 1989) and *Wynn Oil Co. v. Am. Way Serv. Corp.*, 943 F.2d 595 (6th Cir. 1991). The *Roulo* court stated that the Lanham Act had "no express requirement that the parties be in direct competition or that the infringer wilfully infringe the trade dress to justify an award of profits." *Roulo*, 886 F.2d at 941. But it affirmed the trial court's instruction that an

award of profits was appropriate "[g]iven the evidence of *intentional imitation* and the substantial similarity between the two [products]. . . ." *Id.* (emphasis added).

The *Wynn* court quoted the *Roulo* court's statement that there was no express requirement of willfulness or direct competition. *Wynn*, 943 F.2d at 606-07. But contrary to Contessa's suggestion, Pet. Writ Cert. 12, whether willfulness was a prerequisite to an award of profits was not at issue in *Wynn*. The trial court had found that the infringement was willful, a finding that the appellate court determined was not clearly erroneous. *Wynn*, 943 F.2d at 604-05.

Contessa also cites the pre-1999 decision in *Burger King*, 855 F.2d at 781, for the proposition that willfulness is not a prerequisite for an award of profits. Pet. Writ Cert. 12. But the *Burger King* court did not discuss whether "willfulness" is a prerequisite. Instead, it held that a defendant who is "purposely using the trademark" may be subject to disgorgement of profits, but no showing of bad faith is required. *Burger King*, 855 F.2d at 781.

While the courts interpreting the pre-1999 version of section 35(a) differed to some extent on the *degree* of willfulness necessary to support an award of profits, none held that a defendant who was ignorant of the infringement (which is the case here) could be compelled to disgorge profits. Accordingly, certiorari is not warranted by any supposed conflict among the circuits construing the pre-1999 version of section 35(a).

In any event, little purpose would be served by this Court addressing a perceived conflict in the cases construing an outdated version of the statute, the current version of which has been uniformly interpreted by the courts of

appeal. The pre-1999 version of the statute has little or no current legal significance since it applies only to conduct that occurred more than six years ago. This Court's opinion on the subject would be a matter of mere historical interest.

E. The district court's grant of summary judgment was correct on the alternative ground that there was no basis in equity for an award of profits.

The Ninth Circuit's decision affirming the judgment was correct. The district court correctly granted summary judgment because, setting aside any willfulness requirement, the facts did not support an award of defendants' profits. Indeed, the court would have erred had it ordered disgorgement of profits.

The courts of appeals "have articulated three justifications for awarding to plaintiff an accounting of the defendant's profits: (1) as a rough measure of the harm to plaintiff; (2) to avoid unjust enrichment of the defendant; or (3) if necessary to protect the plaintiff by deterring a willful infringer from further infringement." *Tamko*, 282 F.3d at 36; *see Estate of Bishop v. Equinox Int'l Corp.*, 256 F.3d 1050, 1054 (10th Cir. 2001); *Minn. Pet Breeders, Inc. v. Schell & Kampeter, Inc.*, 41 F.3d 1242, 1247 (8th Cir. 1994); *George Basch*, 968 F.2d at 1537. The facts here do not support an award of profits under any of the three justifications.

The first justification, that the defendant's profits roughly measure the harm to the plaintiff, requires that the plaintiff have suffered harm. *Lindy*, 982 F.2d at 1408. Here, the district court granted Berdex and Coast summary

judgment on Contessa's claim for damages because Contessa could not establish the fact of injury. 4 CA ER 950. Contessa did not challenge the court's ruling on appeal. Since Contessa could prove no harm from the alleged infringement, an award of profits would not serve a compensatory purpose.

The rationale behind the second justification, that an award of profits may prevent unjust enrichment of the defendant, is that "the infringer has taken the plaintiff's property as represented by his trade-mark and has utilized this property in making a profit, and that if permitted to retain the profit, the infringer would be unjustly enriched." *Maier Brewing Co. v. Fleischmann Distilling Corp.*, 390 F.2d 117, 121 (9th Cir. 1968). Accordingly, for the second justification to apply, the defendant must have used the trademark to make a profit. Here, however, the record contains "unchallenged evidence that Lockpur's choice of packaging did not affect the purchasing decisions of Defendants' customers." Pet. App. 36a. Thus, whatever profits Berdex and Coast made from the sale of infringing packaging cannot be attributed to the packaging itself, and Berdex and Coast were not unjustly enriched. *See Tex. Pig Stands, Inc. v. Hard Rock Cafe Int'l, Inc.*, 951 F.2d 684, 696 (5th Cir. 1992) (holding that accounting of profits was not justified by unjust enrichment theory where the defendant "'would have sold just as many pig sandwiches by any other name' and that 'there is no basis for inferring that any of the profits received by [Hard Rock] from the sale of pig sandwiches are attributable to infringement'").

The third justification, deterrence, does not support an award of profits here because the district court found – and the Ninth Circuit agreed – there was nothing to deter. In affirming the district court's denial of a permanent

injunction, the Ninth Circuit explained the district court "did not abuse its discretion in concluding . . . that where Defendants had permanently terminated business relations with Lockpur and had neither commercial interest nor motivation to use the allegedly infringing Image, there was not a reasonable likelihood that any allegedly infringing behavior would recur." Pet. App. 7a.

Thus, setting aside willfulness, the district court's judgment and the Ninth Circuit's decision were correct on the alternative ground that no justification exists for an award of profits to Contessa. Accordingly, a writ of certiorari is not warranted.

II. CONTESSA HAS NEVER EXPLAINED WHY THIS COURT'S DECISION IN *METRO-GOLDWYN-MAYER STUDIOS INC. V. GROKSTER, LTD.* REQUIRES THAT THIS CASE BE REMANDED FOR RECONSIDERATION.

Contessa suggests that this Court consider remanding this case for further consideration of the copyright infringement issue in light of the Court's decision in *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 125 S. Ct. 2764 (2005). Because the Court had yet to file its opinion in *Grokster* by the time Contessa filed its petition, Contessa assured the Court and respondents it would "supplement its petition as appropriate when the opinion in *Grokster* is handed down." Pet. Writ Cert. 24.

The opinion in *Grokster* was handed down on June 27, 2005, but Contessa has yet to file any supplemental briefing. Since Contessa has offered no explanation or argument why *Grokster* supports a grant of certiorari in

this case, Contessa's petition on this ground should be denied.

CONCLUSION

For the foregoing reasons, the petition for certiorari should be denied.

Respectfully submitted,

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No. 04-1693

IN THE
Supreme Court of the United States

CONTESSA PREMIUM FOODS, INC.,
Petitioner,

vs.

BERDEX SEAFOOD, INC., *ET AL.*,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

MOTION OF INTERNATIONAL TRADEMARK ASSOCIATION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* IN SUPPORT OF PETITIONER AND BRIEF OF *AMICUS CURIAE* INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF PETITIONER

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Pursuant to Supreme Court Rule 37.2(b), the International Trademark Association ("INTA") moves for leave to file the attached Brief *Amicus Curiae* in support of the Petition for Certiorari. Counsel for Petitioner Contessa Premium Foods, Inc. and all respondents but one have consented or stated no objection to the filing of INTA's brief. Specifically, Respondent Fishery Products International Ltd. has withheld consent, and Mazetta Co. LLC, Hanwa American Corporation, and Admiralty Island Fisheries, Inc. have indicated that they do not object to INTA's filing.[1] Copies of the

[1] Consistent with footnote five in the petition, which identifies only Fishery Products Int'l, Inc., Berdex Seafood, Inc., and Coast to Coast

consent letters have been filed with the Clerk of the Court concurrently with this motion.

INTA requests leave to file the attached Brief *Amicus Curiae* because the issue presented by the petition concerns an aspect of trademark law of importance to INTA's membership – the standard for the recovery of a trademark infringer's profits. Although the availability of monetary remedies to trademark owners is governed by section 35 of the Lanham Act, 15 U.S.C. § 1117, a three-way split has evolved among the Circuit Courts of Appeal on whether a plaintiff must prove willful infringement as a prerequisite to recovering an infringer's profits from the sale of goods bearing an infringing mark. This split in authority directly affects INTA's membership by depriving trademark owners of the nationwide, uniform rights that the Lanham Act was designed to guarantee.

INTA is a not-for-profit organization whose more than 4,300 members have a special interest in trademarks. These members include trademark owners, law firms, advertising agencies, package design firms, and professional associations from the United States and 170 other countries. All share the goals of emphasizing the importance of trademarks and trademark protection, and of promoting an understanding of the essential role trademarks play in fostering informed decisions by consumers, effective commerce, and fair competition.

INTA members frequently are participants in trademark litigation, and therefore are interested in the development of clear and consistent principles of trademark and unfair competition law. INTA has substantial expertise in trademark law and, as set forth in the attached brief, has selectively participated as an amicus curiae in cases involving significant trademark issues.

In keeping with INTA's interest in promoting national uniformity in the application of federal trademark law, INTA's brief requests that the Court resolve a three-way split

Seafood as the only respondents with an interest in the petition, counsel for Sea Port Products Corp. has informed INTA that Sea Port is not a party to the petition for certiorari.

in authority among the Circuit Courts of Appeal on whether a trademark owner must first prove willful infringement as a prerequisite to recovering a trademark infringer's profits. This split frustrates Congress's purpose of providing uniform, nationwide rights for owners of federally-registered trademarks when it enacted the Lanham Act in 1946. Uniform rights are particularly important to INTA's membership in a marketplace increasingly characterized by brands with national and global reach.

The current split in authority also exposes INTA's membership to forum shopping. Owners of federally-registered trademarks have an incentive to bring infringement suits in circuits that do not require trademark holders to prove willful infringement as a prerequisite to the recovery of an infringer's ill-gotten profits. Similarly, parties that have been accused of trademark infringement – but have not yet been sued – have an incentive to file declaratory relief actions in those circuits that require trademark holders to clear the high evidentiary bar of proving willful infringement before a court may consider whether to force the infringer to disgorge its profits. This Court's announcement of a clear, uniform standard as to the relevance of willfulness to the disgorgement of profits in a trademark case is the most effective way to solve this problem.

For these reasons, INTA respectfully requests leave to file the attached brief, and urges this Court to grant the petition for certiorari and restore national uniformity to federal trademark law on this important issue.

Respectfully submitted,

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INTRODUCTION

With this Court's leave, pursuant to Supreme Court Rule 37.2(b),[1] *amicus curiae* International Trademark Association ("INTA"), respectfully submits this brief in support of the petition for certiorari.

INTA requests the Court to resolve a long-standing split among the Circuit Courts of Appeal on whether a trademark owner must prove willful infringement as a prerequisite to recovering the trademark infringer's profits from the sale of goods bearing the infringing mark. INTA does not, in this brief, recommend a particular resolution to the split in authority.[2] Rather, it advocates that the Court take the opportunity that this case presents to grant certiorari to resolve the split in the Circuits and restore the national uniformity to federal trademark law that Congress intended to create in enacting the Lanham Act in 1946.

INTEREST OF *AMICUS CURIAE*

INTA is a not-for-profit organization whose more than 4,300 members have a special interest in trademarks. They include trademark owners, law firms, advertising agencies, package design firms, and professional associations from the United States and 170 other countries. All share the goals of emphasizing the importance of trademarks and trademark protection, and of promoting an understanding of the essential role trademarks play in fostering informed decisions by consumers, effective commerce, and fair competition. INTA members frequently are participants in trademark litigation, and therefore are interested in the development of clear and

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[1] All but one of the parties with an interest in the petition has either affirmatively consented to INTA's filing of this Brief or has indicated that it does not object. The consenting parties' letters of consent have been filed concurrently with this brief. No party to this case authored any part of this brief. No person or entity other than *amicus* or its counsel has made any monetary or other contribution to its preparation or submission.

[2] Should the Court grant certiorari, INTA will seek the consent of the parties to file an *amicus curiae* brief on the merits.

consistent principles of trademark and unfair competition law. INTA has substantial expertise in trademark law and has selectively participated as an *amicus curiae* in cases involving significant trademark issues.[3]

INTA was founded in 1878 as the United States Trademark Association, in part to encourage the enactment of federal trademark legislation after the invalidation on constitutional grounds of this country's first trademark act. Since that time, INTA has been instrumental in making recommendations and providing assistance to legislators in connection with federal trademark legislation, including the particular statutory revision that has exacerbated the split in the Circuit Courts of Appeal identified by the petition. *See* Pub. L. No. 106-43, § 3(b), 113 Stat. 219 (1999).

SUMMARY OF ARGUMENT

INTA submits this Brief *Amicus Curiae* to request that the Court resolve a long-standing split in authority among the Circuit Courts of Appeal on whether a trademark owner must first prove willful infringement as a prerequisite to re-

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[3] Cases in which INTA has filed *amicus* briefs include: *KP Permanent Make-Up, Inc. v. Lasting Impression I Inc.*, 125 S. Ct. 542 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V. Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *Fla. Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank*, 527 U.S. 627 (1999); *Dickinson v. Zurko*, 527 U.S. 150 (1999); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988); *WarnerVision Entm't Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259 (2d Cir. 1996); *Preferred Risk Mut. Ins. Co. v. United States*, 86 F.3d 789 (8th Cir. 1996); *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556 (Fed. Cir. 1994); *Ralston Purina Co. v. On-Cor Frozen Foods, Inc.*, 746 F.2d 801 (Fed. Cir. 1984); *Anti-Monopoly, Inc. v. Gen. Mills Fun Group*, 684 F.2d 1316 (9th Cir. 1982), *cert. denied*, 459 U.S. 1227 (1983); *In re Borden, Inc.*, 92 F.T.C. 669 (1978), *aff'd sub nom. Borden, Inc. v. Fed. Trade Comm'n*, 674 F.2d 498 (6th Cir. 1982), *vacated and remanded*, 461 U.S. 940 (1983); *Redd v. Shell Oil Co.*, 524 F.2d 1054 (10th Cir. 1975); *Century 21 Real Estate Corp. v. Nev. Real Estate Advisory Comm'n*, 448 F. Supp. 1237 (D. Nev. 1978), *aff'd*, 440 U.S. 941 (1979).